

Application Serial No.: 09/879,825

Attorney Docket No. 24122-303-409

In Response to Final Office Action mailed October 10, 2003

REMARKS

In response to the Final Office Action mailed October 10, 2003 (Paper No. 15), no claims have been cancelled or amended. Claim 63 has been newly added. Therefore, claims 47-63 are pending. In view of the following comments, allowance of all the claims pending in the application is respectfully requested.

Information Disclosure Statement (I.D.S.)

Applicants are submitting herewith an Information Disclosure Statement ("IDS"). Applicants respectfully request that the Examiner consider the cited references and provide a signed copy of the Form PTO-1449 for this submission with the next Office Action.

Rejections Under 35 U.S.C. § 112, First Paragraph

Claim 52 stands rejected under 35 U.S.C. §112, first paragraph for allegedly containing subject matter which was not described in the Specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In particular, the Examiner alleges that the Specification does not explicitly disclose a "TCP/IP" network. *See* Final Office Action, pg. 2, ¶4.

Applicants traverse this rejection, and maintain the arguments previously presented in the Response to Paper No. 11, submitted September 12, 2003, at §B, pgs. 8-9. Applicants further note the Examiner's acknowledgement that the Internet is "*one manifestation of a TCP/IP network.*" *See* Final Office Action, pg. 9, lines 2-3.

Application Serial No.: 09/879,825

Attorney Docket No. 24122-303-409

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Rejections Under 35 U.S.C. §103

A. Nichtberger, Valencia, and Cameron

Claims 47-51 and 53-60 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Patent No. 4,882,675 to Nichtberger *et al.* ("Nichtberger") in view of U.S. Patent No. 5,380,991 to Valencia *et al.* ("Valencia"). *See* Final Office Action, pg. 3, ¶5. Claim 52 stands rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over the combination of Nichtberger and Valencia, further in view of U.S. Patent No. 5,592,378 to Cameron *et al.* ("Cameron"). *See* Final Office Action, pg. 6, ¶6.

Applicants traverse these rejections, and maintain the arguments previously presented in the Response to Paper No. 11, submitted September 12, 2003, at §C, pgs. 9-16.

B. Von Kohorn

Independent claims 47, 57, 61, and 62 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Patent No. 5,227,874 to Von Kohorn. *See* Final Office Action, pg. 7, ¶7. Applicants traverse this rejection.

Von Kohorn, which is non-analogous art with respect to Applicants' invention, is primarily directed toward a method for evaluating the short and long term effectiveness of broadcast stimuli (*e.g.*, television and radio signals) and print stimuli on individuals (*e.g.*, shoppers). In various embodiments, Von Kohorn utilizes a custom response unit that may be placed in systematically or randomly selected homes, used for desired research purposes and thereupon moved to new locations. *See* Von Kohorn, *e.g.*, col. 20, lines 8+. Consumers may, in response to answering questions or following other instructions during a broadcast, receive inducements (*e.g.*, coupons). Such inducements may be outputted via a special dispenser associated with the custom response units. In at least some embodiments, an inducement is printed on a special matrix. Von Kohorn further discloses redemption of inducements (*e.g.*, coupons) by mail, by telephone, or in-person (*e.g.*, col. 87, lines 55-66).

Application Serial No.: 09/879,825

Attorney Docket No. 24122-303-409

In Response to Final Office Action mailed October 10, 2003

In the Final Office Action, the Examiner *appears* to concede that Von Kohorn does not explicitly disclose *electronic* redemption of an electronic coupon stored on the client system:

Von Von Kohorn [sic] does not explicitly disclose that electronic coupon is electronically transmitted redemption. *See* Final Office Action, pg. 7, ¶7.

The Examiner alleges, however, that it would have been obvious to add electronic redemption to Von Kohorn's varied manners of redeeming incentives so that users have "...*an additional and convenient way of redeeming incentives.*" *See* Final Office Action, pg. 8. Applicants disagree.

There appears to be no teaching, suggestion, or motivation to modify Von Kohorn to enable electronic redemption. Assuming arguendo that there was a teaching, suggestion, or modify Von Kohorn as the Examiner suggests, the rejection would still be improper as Von Kohorn, even when modified, would still fail to disclose, teach or suggest all of the claim elements.

In particular, each of independent claims 47, 57, 61, and 62 include the claim feature of a second (or subsequent) server detecting the electronic coupon stored on the client system. The Examiner alleges, in the Final Office Action at pg. 7, ¶7, that this feature is disclosed by Von Kohorn at col. 3, lines 3-22. However, this passage, which is reproduced below, does not appear to disclose, teach, or suggest a second (or subsequent) server detecting the electronic coupon stored on the client system:

The response units at individual shoppers' locations have means for dispensing individual coupons following a response and for compiling a cumulative record of products for which the shopper has requested or selected discount coupons. Such a cumulative record can take the form of a tape intermittently printed as coupons are requested. Whereas the coupons are dispensed individually when printed as described in connection with the drawings, the tape matrix having the cumulative coupon data printed thereon is temporarily retained in the response unit in the form of a tape.

It is removed and replaced the way the tapes of known calculators are retained until fully used, at which time they are replaced.

In the event a shopper uses, i.e. redeems all of the coupons requested by purchasing the specified product, the total number of products thus purchased will equal

Application Serial No.: 09/879,825

Attorney Docket No. 24122-303-409

In Response to Final Office Action mailed October 10, 2003

the number of products listed on the cumulative record compiled by the response unit of that shopper. *See* Von Kohorn, col. 3, lines 3-22.

For *at least* the reason that the passage relied upon by the Examiner does not appear to disclose, teach, or suggest the feature of a second (or subsequent) server detecting the electronic coupon stored on the client system, Applicants submit that the Examiner has failed to establish a *prima facie* case of obviousness. For *at least* the reasons set forth above, Applicants submit that the rejection of independent claims 47, 57, 61, and 62 is improper, and should be withdrawn.

Interference

Having addressed each of the foregoing rejections, it is respectfully submitted that a full and complete response has been made to the outstanding Office Action. As such, Applicants request that an interference be declared between the above-identified application, and U.S. Patent No. 6,076,069 to Laor.

Application Serial No.: 09/879,825

Attorney Docket No. 24122-303-409

In Response to Final Office Action mailed October 10, 2003

CONCLUSION

Having addressed each of the foregoing rejections, it is respectfully submitted that a full and complete response has been made to the outstanding Office Action and, as such, the application is in condition for allowance. Notice to that effect is respectfully requested.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Respectfully submitted,

Date: April 6, 2004

By:


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